

random generator. The coin 27 has opposed sides with a head or tail. Figure 5 is partial view of a game having a wheel used for random selection. Wheels may be spun by the dealer, a motor or as a virtual video wheel; the latter two wheels are typically controlled by a random number generator in many types of casino equipment. U.S. Patent number 5,823,874 has a bonus indicator in the form of a rotating bonus wheel that can be caused to spin automatically or in response to some action by a player, e.g., pushing a button so the primary reels indicate one of a predetermined plurality of indicia. When the wheel stops, a pointer indicates the bonus payout to be awarded to the player. Be it a wheel Figure 5 or a spinner Figure 2 the idea of a random selection is common in this field.--

In the claims, please amend as follows:

- 1) (Twice amended.) A method for playing a casino game of chance for a bet with random entry from an underlying slot machine to a bonus game of the casino game of chance, the method for playing [in] a casino game comprising the steps of:
  - a) establishing a plurality of paths in the play of the bonus game of the casino game of chance, each of which path[s] is comprised of a plurality of positions;
  - b) establishing a random means of traversing the paths in the play of the bonus game of the casino game of chance;
  - c) presenting [affording] with the random means the possibility of two or more moves being required to complete the bonus game;
  - d) allowing a player to select one of the paths in the play of the bonus game of the casino game of chance;
  - e) moving according to the random means [along path selected by the player,] along a selected path by the player;
  - f) providing at least one position having a win or loss outcome;

- g) awarding the player monetary or credit values [as] based upon wins or losses associated with positions landed upon, and
- h) [controlling the house advantage of the casino game to a predetermined range by] relating [the] a random frequency of the bonus game to the probability of landing on each position and to the value of each position so a predetermined range for a house advantage is maintained in the casino.
- 2) (Thrice amended.) The method of claim 1 with one or more value [squares] positions along the paths in the play of the bonus game of the casino game of chance.
- 3) The method of claim 1 wherein the random means is performed by spinning a spinner.
- 4) The method of claim 1 wherein the random means is performed by rotating a wheel.
- 5) The method of claim 1 wherein the random means is performed by rolling at least one die.
- 6) The method of claim 1 wherein the random means is performed by flipping a coin.
- 7) The method of claim 1 wherein the random means uses a random number generator.
- 8) (Thrice amended.) The method of claim 1 [wherein] with the step of establishing a plurality of paths, each of which paths is comprised of a plurality of positions and with the step of having one of the positions as a stop position on one of the paths in the play of the bonus game of the casino game of chance [includes using a stop position].
- 9) (Thrice amended.) The method of claim 1 wherein landing on certain [squares] positions along the selected path in the play of the bonus game of the casino game of chance causes additional movement.
- 10) (Once amended.) The method of claim 1 by establishing intersecting paths in the play of the bonus game of the casino game of chance.

- 11) (Thrice amended.) The method of claim 1 with the step of establishing one or more positions along the selected path in the play of the bonus game of the casino game of chance having an associated game.
- 12) (Thrice amended.) A method for playing a casino bonus game for a casino base game, comprising the steps of:
- a) establishing in the play of the casino bonus game a plurality of paths , each of which paths includes a plurality of positions with at least one value position there between;
  - b) moving along a player selected path provided with a [with a provided] random selection;
  - c) providing at least one position having a win or loss outcome;
  - d) awarding the player monetary or credit values [as] based upon wins or losses associated with positions landed upon, and
  - e) [controlling the house advantage of the casino game to a predetermined range by] relating [the] a random frequency of the bonus game to the [probably] probability of landing on each position and to the value of each position so a predetermined range for a house advantage is maintained in the casino.
- 13) The method of claim 12 wherein the step of moving includes a stop position.
- 14) The method of claim 12 wherein the step of moving includes random selection of positions that cause additional movement.
- 15) The method of claim 12 wherein the step of establishing plural paths includes at least one position common to the plural paths whereat the paths intersect.
- 16) The method of claim 12 wherein the establishing step includes one or more value positions having an associated game.
- 17) (Thrice amended.) A method for playing a casino game of chance, comprising the steps of:

- a) establishing in the play of the casino game a plurality of paths, each having at least two positions;
- b) allowing a player to select one of the plurality of paths in the play of the casino game of chance;
- c) moving along one of the plurality of paths selected by the player in step b) [the player selected path] according to chance;
- d) providing at least one position having a win or loss outcome;
- e) awarding the player monetary or credit values [as] based upon wins or losses associated with the selected path in the play of casino game of chance, and
- f) [controlling the house advantage of the casino game of chance to within a predetermined range by] relating [the] a random frequency of the bonus game to the probability of landing on each position and to the value of each position so a predetermined range for a house advantage is maintained in the casino.

18) (Once amended.) The method of claim 17 for playing a casino game of chance by playing a base game and a bonus game in the play of the base game and the bonus game of the casino game of chance.

19) The method of claim 18 for playing a casino game wherein the step of controlling the house advantage provides a total range thereof of about twenty percent.

20) The method of claim 18 for playing a casino game wherein the step of controlling the house advantage includes a range for the player selected best path to the player selected mean path of about fifteen percent in the play of the base game and the bonus game of the casino game of chance.

21) The method of claim 17 wherein the step of moving according to chance uses the spinning of a spinner.

22) The method of claim 17 wherein the step of moving according to chance uses the rotating of a wheel.

23) The method of claim 17 wherein the step of moving according to chance uses the rolling of at least one die.

- 24) The method of claim 17 wherein the step of moving according to chance uses the flipping of a coin.
- 25) The method of claim 17 wherein the step of moving according to chance uses a random number generator.
- 26) (Once amended.) The method of claim 17 wherein the step of establishing a plurality of paths in the play of the casino game of chance, each of which is comprised of a plurality of positions includes using a stop position.
- 27) The method of claim 17 wherein landing on certain positions causes additional movement.
- 28) The method of claim 17 wherein the paths intersect.
- 29) The method of claim 17 with the step of establishing one or more positions having an associated game.
- 30) The method of claim 17 with the step of allowing the player to acquire items.
- 31) The method of claim 17 with the step of allowing the player to acquire privileges.
- 32) (Thrice amended.) A casino game of chance for at least one player comprising:
- a) a game surface accessible and visible to the player in the casino;
  - b) a plurality of paths on the game surface arranged for player selection of one path, each path having at least two positions beginning at start position, and finishing at end position;
  - c) at least one position having a win or loss outcome;
  - d) movable indicia on the game surface, the movable indicia for showing the position on [the] a selected path of the player;
  - e) a mechanism of chance carried on the game surface and available to the player in the casino, the mechanism of chance for determining movement along the player selected path and awarding the player monetary or credit

values associated as wins or losses with positions along the selected path,  
and

- f) structure in the casino game of chance to [control the house advantage to a predetermined range by] relate[ing] [the] a random frequency of [the] a bonus game to the probability of landing on each position and [the] to a value of each position so that [the] an expected monetary or credit value of each of the [plurality of] paths is approximately identical for a house advantage is in a predetermined range.

#### *Oath/Declaration*

The Examiner notes that the instant application does not contain a proper power of attorney for Charles McCrea, Jr. and Applicant has merely stated to direct all correspondence to: Charles McCrea, Jr., but has failed to provide customer number for Mr. McCrea, Jr. It appears to the Examiner that Mr. McCrea, Jr. is, acting in a representative capacity under 37 CFR 1.34, i.e. Applicant has executed a power of attorney for the undersigned registered patent attorney filed herewith. With specific regard to the above inquiry Mr. Charles McCrea, Jr. is an officer of the assignee of the application per the assignment recorded in the United States Patent and Trademark Office at Reel /Frame 011386/0899 on 12/14/2000. Consequently, correspondence is addressed to Charles McCrea, Jr. in his capacity as a representative of the assignee, Mikohn Gaming Corporation.

#### *Drawings*

The drawings are objected to by the Examiner under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, "the casino game of chance with random entry from an underlying slot machine to a bonus game" and "the structure in the casino game of chance to control the house advantage" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

The drawings are objected to under 37 CFR 1.83(a) because they fail to show "start position and finish position", "die", "flipping a coin", "random number generator", "a base and a bonus game" as described in the specification. Any structural detail that is essential

for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Correction is required.

On pages 4, 7 and 11-14 the flow charts should be incorporated in the drawings and not in the specification. Correction is requested by the Examiner.

Applicant has submitted herewith draft drawings including revised Figure 1 and the flow charts removed from the written specification of the application. A clean copy of the amended application submitted with deletion of the flow charts and all the amendments included with this reply. The Examiners approval is respectfully requested. No new matter is included in these drawings or amendments. In Figure 1 Applicant has changed the drawing to a block diagram so that the reference number 17 represents all the types of mechanism of chance known to skilled artisans. In the detailed description as filed Applicant stated:

“A mechanism of chance 17 carried on the game surface 11 is available to the player. The mechanism of chance 17 is for determining the random movement of the indicia 16 along the player selected path 13 and for awarding the player any values associated with positions along the selected path 13. As set forth herein before the mechanism of chance 17 can include, spinners, dice, wheels, random number generators or a coin for flipping, etc. The expected value for each possible player choice of paths is designed to preserve the house advantage and make the casino game of chance 10 commercially viable.”

Consequently, the changed Figure 1 proposed for the Examiner's approval does not include any new matter and is consistent with overcoming the objection raised. Similarly in the detailed description on pages 4 and 7 this appears, “Start” on the left consequently end would be in the direction of the now added arrow, i.e., to the right. Labeling of start and stop in Figure 1 is entirely consistent.

Finally, bonus games are well known in connection with slot machines and certainly within the abilities of skilled artisans. The additions of the slot machine to the bonus game of Figure 1 is within the common knowledge in the field and is taught in many issued patents. The figures for the spinner die and random number generator are within the disclosures of many existing patents in the field and thus known to skilled artisans before the filing of the present application. Consequently, no new matter has been added. As requested by the Examiner, Figures 2, 3, 4, 5, 6, 7, 8, 9 and 10 are added as additional drawings, and as part of the brief and detailed descriptions of the drawings by the herewith submitted

amendments. The Examiner's approval and entry of the drawings is requested. A clean specification and claims including all the amendments is submitted with this response.

***Correction of Claim Objections made by the Examiner***

The term "square or squares" had been changed in claim 1 to "position" or "positions"; the remaining dependent claims have by these amendments no longer contain the term "square or squares". Correction has been made in the amended claims submitted herewith as requested so that the terms are now "position" or "positions".

Claim 1 is objected to by the Examiner because of the following informalities: line 5, "paths" should be --path--; line 10, "along path selected by the player" should be --along a selected path by the player--. Applicant has made the suggested changes with the amendment submitted herewith.

Claim 8 is objected to by the Examiner because of the following informalities: line 3, "of positions includes using a stop position" it is unclear what is meant by the above sentence. Applicant has positively recited having one of the positions as a stop position in amended claim 8.

Claim 11 was objected to by the Examiner because of the following informalities: line 6, "with a provided" should be --provided with a--; line 12, "probably" should be --probability--. Applicant has amended claim 12 as that appears to have had the noted objections which are amended as per the Examiner's instructions.

***Claim Rejections - 35 USC § 112*** second paragraph of 35 U.S.C. 112:

Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

According to the Examiner:

In claim 1, there is no recitation of wherein the wager or bet is imputed so Applicant has in the preamble to claim 1 add that the bet is made in the slot machine.

In claim 1, line 3, "playing in a casino" has not been positively recited. The term, "in" has been removed.

In claim 1, line 7, "c) affording with the random means . . ." it is unclear to the Examiner what is meant by this sentence. Applicant has changed the term "affording" to --



presenting--. Affording was a used in the normal sense of its meaning, i.e. giving, offering or presenting so the change is not different in meaning but is a perhaps a more familiar term.

Claim 1 recites the limitation "the house advantage" in line 14; "the random frequency" in line 15. There is insufficient antecedent basis for this limitation in the claim. Applicant has amended claim 1 to overcome the rejections by positively reciting both phrases.

Claim 12 recites the limitation "the house advantage" in line 10; "the random frequency" in line 11. There is according to the Examiner insufficient antecedent basis for these limitations in the claim. Applicant has amended the method claim to positively recite these elements.

Claim 17 recites the limitation "the player selected path" in line 6; "the overall house advantage" in line 9;"the random frequency" in lines 10-11;"the bonus game" in line 11. According to the Examiner there is insufficient antecedent basis for these limitations in the claim. Applicant has amended method claim 17 to positively recite these elements.

Claim 32 recites the limitation "the selected path" in line 8; "the house advantage" in lines 14-15; "the random frequency" in lines 15-16; "the bonus game" in line 16; "the value of each position" in line 17; "the expected monetary or credit value" in lines 17-18. According to the Examiner there is insufficient antecedent basis for these limitations in the claim. Applicant has amended claim 32 to positively recite these elements.

Not one of Applicant's preceding amendments in this section of the reply has been made on an art rejection. Those amendments are as a result of the Examiner's objections and rejections based on form and/or clarity. For the record, it is Applicant's position that patentability issues on prior references were not the reasons for these amendments.

### ***Claim Rejections - 35 USC § 103***

Claims 1-7, 9-12,14-25 and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker (4,887,819) in view of Harris et al (4,930,789).

Regarding claims 1, 2, 10,12,15, 17-20, 28 and 30-32, the Examiner states, Walker discloses a method of playing a game in conjunction with a slot machine comprising a path having a plurality of squares (see Figure 1). And also, Walker teaches establishing a random means of traversing the path while awarding the player the values associated with

squares landed thereon (see column 10, lines 35-40 and 64-66); Walker further teaches providing a "croupier or attendant at a gaming table" for handling the casino bank, paying, receiving and exchanging chips, basically for controlling the house advantage of the casino game (column 6, lines 35-49).

Applicant respectfully does not agree with the Examiner's explanation and analysis of Walker as the croupier or attendant does not control the house advantage. Taking in bets and paying out wins is not control of the house advantage, it is merely acting as the bank. The house advantage is not controlled in Walker because the house take is inherent, i.e. it is what it is depending on the game rules. Walker is not a casino game as it would be illegal as it fails to comply with the regulation of casino gaming in any jurisdiction permitting casino gaming. The commercial viability and regulatory approval of casino games of chance mandate a calculable house advantage in order to meet the verifiable minimum return to the player as regulated by each particular jurisdiction. For example, in Nevada the game manufacturer must be able to show that the device is able to return at least 75 percent of the wager. In fact most machines are set to return significantly more as players and competition necessitate minimum pay backs in the 90 percent range. In Minnesota there is a ceiling of 95 percent over which the casino games must not pay out. There rules have either ceilings, floors or both in gaming jurisdictions. Meeting all the various regulations presents considerable challenges to the inventor of casino games with choices such as Applicant has disclosed and claimed.

To the extent that there might be an inherent house advantage in a random casino game of chance the croupier or the equivalent in Walker should have no control or responsibility for that except to the extent that the regulated casino game is played according to its rules. Consequently, the subject matter of Applicant's claims as a whole would not have been obvious in view of Walker at the time the invention was made to a person having ordinary skill in the art to which its subject matter pertains. The skilled artisan is not someone that designs board game as described in Walker as follows:

"One player is chosen as croupier, and he may or may not be a gambler. If one of the gamblers is to be the croupier, then the croupier can also be chosen by spinning the roulette wheel. The croupier is responsible for handling the casino bank, paying and receiving the appropriate number of chips, exchanging chips between players and the casino bank, and removing chips from the game board."

The Walker casino bank in a home game is not the house or casino and to imply that is wrong as the croupier does not get paid by the house or casino and no chips or share thereof are retained for or by the house or casino as there is none. Walker is very clear about what is disclosed and it is not in relation to what the Examiner has proposed. The following quote from Walker is Applicant's proof of the limited disclosure of Walker.

"The present invention provides a family board game that simulates the excitement of a gambling casino brought directly into the family home. The present game incorporates non-repetitive play, chance, logic, and intelligent decision making, should retain the interest of all players for an extended length of time, and can be adjourned and then reassumed."

Thus Walker has none of what Applicant claims and Walker is a completely different game played in a manner that would be unacceptable for a casino.

The Examiner admits that, Walker as described lacks Applicant's claimed (a) a plurality of paths, (b) allowing a player to select one of the paths, (c) each path having a start and an end position. The Examiner argues that functional recitations, the intended use of the game as a base game or bonus game, have not been given patentable weight since the Walker shows the structural limitations and these limitations are not limited to one method of play. Applicant respectfully disagrees in that Walker is limited to a method of playing a home board game. Applicant has amended the claims to specifically recite wherein appropriate, "in the play of the casino game of chance" and that is not functional in Applicant's amended claims are directed to a method of playing a casino game of chance. The domain of Applicant's amended claims could not be more clear and steps of the Applicant's method of playing a casino game of chance to the extent possible include elements that describe the use and play in a casino game of chance.

Applicant has amended the claims so that positive recitations of method steps and apparatus are those that are lacking in Walker's disclosure. Consequently, Applicant's claims are patentable there over and are not obvious in view there of. The crux of the matter is that until Applicant's disclosure no other inventor or artisan appreciated or knew how to secure the house advantage in casino games and methods as claimed. Because of the regulatory requirements no one had found a way to make an allowable regulated

casino game with a calculable house advantage as claimed. There was no reason to do so in the Walker home game board. Thus, there would not have been any teaching or suggestion in Walker of what a skilled artisan would have done because the Walker reference has nothing directed to having an ascertainable house advantage for the casino. There is no casino or house in Walker, see for example this quote therefrom:

"The object of the game is to accumulate as many chips as possible by gambling and by winning chips without going "busted." The player having the largest number of chips when the casino bank goes busted wins or the last player after the other players have gone busted wins."

In the first action the Examiner admitted that Walker lacks specifying the overall house advantage is controlled and now suggests that with given the structure of the Walker device the Applicant's method of play is possible. Perhaps possible but certainly not taught or obvious in view of Walker. Obviousness is the standard; a possibility is less than the statutory requirement of what a skilled artisan would have known. Thus, Applicant does not agree with the Examiner's view of Walker, the Examiner's application of Walker or the Examiner's reading of Applicant's claims. Walker's disclosure is not and can not be a casino game and so there would have been no reason for a skilled artisan to even consider the house advantage in view of Walker. Thus, no motivation to play or to have a game according to Applicant's claimed methods and apparatus exists in Walker or any reasonable interpretation of it apart from the Examiner's conclusions.

Until the present disclosure no one suggested either the claimed methods or apparatus. It was at the time of Applicant's filing surprising and unexpected that the house advantage can be maintained within a predetermined range for the claimed casino game of chance. To provide the player multiple choices and meet the range of regulated payback would not have been obvious. Players like to have choices, casinos wish to provide variety and regulators want to control the pay back; that combination is not disclosed in Walker or obvious in view of its teaching. The present claims recites how to meet these seemingly different limitations in methods of and apparatus for playing a casino game of chance. In particular, the players want to be able to make strategic choices that give them a feeling of control over the play of the game and thus maximize their opportunities to win and minimize their probabilities of loss. The Applicant was the first to develop and claim casino

methods and apparatus that allow players' choice, assures house advantage and have a calculable return to satisfy regulators.

Walker according to the Examiner:

- 1) defines a path that inherently has two ends (see Figure 1, numerals 101 and 144).
- 2) claimed a path that has a general racetrack shape (see column 11, lines 53 and 54).

Reference numbers in Walker are referred to as, "ends" and only by inference could one say that 101 is the beginning and 144 is the end. The ordinary dictionary meaning of oval is a continuous curve of a particular configuration; that is generally elliptical or egg shaped. While there is a discontinuity in the path of Walker and one could say that the end boxes 101 and 104 are a start and finish, the play of the game is not a race so much as a trip to different gaming devices whereat chips may be won or lost. Thus Applicant does not think that skilled artisans would have known an oval has any end and to say that end boxes are either a beginning or an end is to imply that the lines function to define merely what they are as there is no real race to get from 101 to 144 in Walker. Applicant feels that Walker does not teach a race track and that the use of those terms therein is in connection with reference number 100 the cleaners box not the oval.

- 3) teaches that the shape of the path as depicted in Figure 1 can be changed and the path can have greater or lesser number of boxes (see column 10, lines 58 to 61).

It is not seen by the Applicant or explained by the Examiner how the number of boxes is particularly relevant to Applicant's claims. Applicant's claims are patentable over Walker for all of the reasons, distinctions and arguments made. Thus, rejection of claims to start and end positions on Walker without more must fail as Applicant's claims are patentable and should be reconsidered and allowed.

According to the Examiner, Harris et al. show a game employing a plurality of intersecting paths (see Figure 1). The player, when meeting a certain requirement, is also allowed to select a given path (see column 6, lines 33-37).

Applicant believes that, the cited part of Harris et al. teach exactly opposite what the Examiner suggests. The particular portion of Harris et al. cited by the Examiner and importantly, what precedes it is reproduced below:

"When a playing piece terminates movement on any gaming path entrance 77, or if a player is instructed to advance to a gaming path interval 25, player must meet the entrance requirements of that particular path. Each gaming path has individual entrance requirements, if a player can't meet the entrance requirements of a particular gaming path, the player may not enter that path, then on the players following turn, the player must continue around the main path."

From the quote, it is clear that, no player selection of paths is disclosed in the Harris et al. disclosure. In fact quite the opposite is taught as the player has no choice and must follow the rules of Harris et al. Specifically, the player must qualify to follow an alternate to the main path. No selection is available to the player as proposed by the Examiner. It is very important aspect of the presently claimed invention to let the player have apparent control of the play with choice. Thus, a casino game that is indeed random and purely chance can be played by the knowledgeable, skilled or experienced player in several player selected ways so that it seemly pays better while maintaining the calculable house advantage. Thus, the casino is secured, the players feel they are in control and the regulators are satisfied that the casino game return is legally between calculable predetermined limits. The Applicant was the first to disclose and claim methods and apparatus to satisfy these seemingly conflicting aims.

While the multiple paths of Harris et al. lend variety to the main path providing detours to other games, nothing in the set up or play of the multiple paths of Harris et al. is at all similar or suggestive of Applicant's claimed methods of play using multiple paths that give the player choices. Specifically, Applicant's disclosed and claimed methods with multiple paths give the players choices that have, as far as the casino is concerned, similar expected value. There is absolutely no player choice in Harris et al. see column 6, lines 29 to 37, set forth previously, wherein the idea of player choice is specifically disavowed by the requirements that must be met for the entrance to a particular gaming path. Thus, Applicant's claimed invention is not taught in Harris et al. and no combination with Walker would have rendered obvious Applicant's claimed methods of or apparatus for game play.

Again, Harris et al. is not a casino game and so the issues of regulatory approval and casino house advantage are unappreciated and not taught. The Examiner cites Harris et al. saying that it supplies what is missing in Walker but only with regard to multiple paths. Applicant's amended claims recited values of the different positions on the paths and how the paths relate to each other so that their respective expected values provide a house advantage in a predetermined range. The pending independent claims include that limitation and thus all the dependent claims also include those claimed aspects making Applicant's methods and apparatus a patentably unique and viable casino game.

Regarding dependent claims 3-7 and 21-25, the Examiner cites Walker as it shows that the dice can be used as a random chance device (see column 10, lines 64-66). Using a spinner, rotating wheel, coin flipping or random number generators are considered equivalent chance devices in the game art. It has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8. If it is only routine skill then Applicant's dependent claims which claim a spinner, a die, etc. should be permitted without need of a drawing as skilled artisans would by the Examiner's position have known of each. The Examiner cites the MPEP that, any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d) but the Examiner fails to explain how there could not be a proper understanding in view of what is common. Figures have been added to accommodate the Examiner's position. Most importantly, Applicant believes that these dependent claims are patentable over Walker for all of the reasons, distinctions and arguments made in connection with the independent claims from which they depend. Thus, rejected dependent claims 3-7 and 21-25 are patentable and should be reconsidered and allowed.

Regarding dependent claims 9, 14 and 27, Walker shows per the Examiner certain squares (or positions) causing additional movement (see column 3, lines 61-65). Applicant believes that these dependent claims are patentable over Walker for all of the reasons, distinctions and arguments made in connection with the independent claims from which they depend. Thus, rejected dependent claims 9, 14 and 27 are patentable and should be reconsidered and allowed.

Regarding dependent claims 11, 16 and 29, Walker shows as pointed out by the Examiner establishing squares (or positions) having associated games (see column 3, lines 36-49). Applicant believes that these dependent claims are patentable over Walker for all of the reasons, distinctions and arguments made in connection with the independent claims from which they depend. Thus, rejected dependent claims 11, 16 and 29 are patentable and should be reconsidered and allowed.

Claims 8, 13 and 26 are now rejected under 35 U.S.C. 103(a) as being unpatentable over the prior references, as applied by the Examiner to claims 1, 12 and 17 above, and further in view of a new reference Wilkins et al et al (5,810,359). Walker as modified above by the Examiner meets accordingly the claimed invention except specifying a "stop" position. Wilkins et al shows a marked action space that has no effect equivalent to a "stop" position (see Figure 1, numeral 20).

Figure 1 numeral 20 shows a "Go To Jail" square on a Monopoly ® game board. Applicant does not agree that this is either a stop position or a game ending position. Regarding the latter it clearly does not end the play of a Monopoly® game. The play is only temporary side tracked or delayed when the player can lose up to four turns. One possibility is that the player has a get out of jail card and is not delayed at all. Thus, the unlucky player who has to go to jail is merely delayed and not stopped. Although that jailed player's movement may cease for up to four rounds after the "Go to Jail" instruction, it delays but does not stop the player as in manner of the Applicant's disclosure and claims. In the play of Applicant's casino game, certain positions or squares are designated "stop". These are where the player pauses upon landing on those positions or squares. As such, the player stops on the position or square instead of traversing it in the normal fashion. The next move continues with the player initiating movement from "stop".

Moreover, Walker according to the Examiner teaches the use of cards to effect no gaming action by losing a turn to other player (see column 5, line 55). Therefore, the Examiner argues that would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a space into the game board that corresponds to no



gaming action for adding a extra chance element to the game play. Applicant firmly believes the losing a turn in Walker is exactly the same as being stuck in jail and not similar to the Applicant's stop position(s) or square(s).

Again Walker teaches a temporary deferral of play not a stoppage as per Applicant's game. Consequently, Applicant does not agree with the Examiner's analysis of either Walker or Wilkins et al.

### ***Response to Arguments***

Applicant's arguments filed 03/08/01 have been fully considered by the Examiner but they were not persuasive.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, to combine Walker with Harris et al would enhance the game at the same time provide a more simulating game.

In response to Applicant's argument that Walker and Harris et al are non-analogous art, it has been held that a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the Applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both references (Walker and Harris et al) describe a "casino board game", which meet the limitations of the subject invention. The claims merely suggest that it is "a